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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,031	10/24/2005	Josef Laumen	112740-1059	9038

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BELL, BOYD & LLOYD, LLP  
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CHICAGO, IL 60690

EXAMINER
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BROOKS, SHANNON

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/529,031

Applicant(s)

LAUMEN ET AL.

Examiner

Shannon R. Brooks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14, 15, 17-21 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 15, 17-21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

The argued features, i.e., “providing at least one radio communication terminal including a device for user identification, the device being one of a SIM and a USIM”, “providing at least one device for providing the paying services within an independent network”, “making a request for one of the paying services by the radio communication terminal”, “transmitting in response to the request, at least one message generated by the user identification device to the device for providing the payment service, “wherein the at least one device is formulated as a command set implemented in the user identification device as specified in one of a SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit”.

The argued features read upon Capitant as follows.

Capitant is discussing a process for making secure remote payments for goods and services using a mobile telephone with access to a network, a payment server, and a management center. Capitant clearly discloses “providing at least one radio communication terminal including a device for user identification, the device being one of a SIM and a USIM”.

Therefore, Capitant meets the claim limitation of “providing at least one radio communication terminal including a device for user identification, the device being one of a SIM and a USIM”.

Capitant clearly discloses “providing at least one device for providing the paying services within an independent network”. Therefore, Capitant meets the claim limitation of “providing at least

one device for providing the paying services within an independent network". Capitant clearly teaches "making a request for one of the paying services by the radio communication terminal". Therefore, Capitant meets the claim limitation of "making a request for one of the paying services by the radio communication terminal". Capitant clearly discloses "transmitting in response to the request, at least one message generated by the user identification device to the device for providing the payment service". Therefore, Capitant meets the claim limitation of "transmitting in response to the request, at least one message generated by the user identification device to the device for providing the payment service". Capitant clearly teaches and discloses "wherein the at least one device is formulated as a command set implemented in the user identification device as specified in one of a SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit". Therefore Capitant meets the claim limitation of "wherein the at least one device is formulated as a command set implemented in the user identification device as specified in one of a SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit".

1. Concerning dependent claims, Capitant alone, or in combination with secondary references discloses the limitations of the dependent claims, as discussed in the following office action.
2. Concerning any arguments on motivation and combination, the cited references are analogous and the motivations are clearly shown in the background of the references. Therefore, all references are combinable.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 14, 15, 17-19, 21, and 24-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Capitant (US 006976011B1) in view of Pailles (US 2004/0083166 A1).

Consider **Claim 14**, Capitant et al. clearly teach and disclose a method for providing paying services within a radio communication network operating in accordance with one of a GSM Standard and a UMTS Standard, the method comprising: providing at least one radio communication terminal including a device for user identification, the device being one of an SIM and a USIM (**Col. 6, lines 51-53**); providing at least one device for providing the paying services (**read as payment server**)(**Col.2, line 49**) within an independent network of the communication network (**read as the Internet**)(**Fig. 1, line 9**); making a request for one of the paying services by the radio communication terminal (**Col.1, lines 44-50**); and transmitting, in response to the request, at least one message (**read as data related to payment**)(**Col. 4, lines 58-63**) generated by the user identification device to the device for providing the paying services, except that it does not specifically teach wherein the at least one message is formulated as a command set implemented in the user identification device as specified in one of an SIM Application Toolkit, a USIM Application Toolkit, and a Card Application Toolkit. However, Pailles teaches wherein the at least one message is formulated as a command set implemented in the user identification device as specified in one of an SIM Application Toolkit, a USIM Application Toolkit, and a Card Application Toolkit (**Pg.3, [0058], and [0071]**). Therefore it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Pailles into Capitant to use one of an SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit to guarantee the integrity and confidentiality of messages (**Pg. 3, [0071]**).

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Consider **Claim 15**, Capitant et al. clearly teach and disclose a method for providing paying services as claimed in claim 14, wherein the device for providing the paying services, upon receipt of at least one message, effects a method comprising: initiating a check of an account status assigned to the user identification device (**Col.3, lines 11-13**); enabling provision of the requested paying service if a result of the check is positive (read as subscriber is authenticated)(lines 26-29); and blocking provision of the requested paying service if the result of the check is negative (read as subscriber is not authenticated).

Consider **Claim 17**, Capitant et al. clearly teach and disclose a method for providing paying services as claimed in claim 14, wherein the at least one message contains a first item of information (**read as subscriber identification**)(**Col.2, lines 43-47**) identifying the radio communication terminal.

Consider **Claim 18**, Capitant et al. clearly teach and disclose a method for providing paying services as claimed in claim 17, wherein the at least one message contains a second item of information (**read as buyer's authentication**)(**Col.3, lines 44-57**) identifying a current service request.

Consider **Claim 19**, Capitant et al. clearly teach and disclose a method for providing paying services as claimed in claim 14, wherein the at least one message describes an order of the services (**read as prices**) requested by the radio communication terminal (**Col. 9, lines 3-6**).

Consider **Claim 21**, Capitant et al. clearly teach and disclose a user identification device in a radio communication terminal for use in a method for providing paying services within a radio communication network operating in accordance with one of a GSM Standard and a UMTS

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Standard, comprising parts for generating, upon a request being made for one of the paying services **(data about the prices) (Col.9, line 5)** by the radio communication terminal, a request message addressed to a device for providing the paying services within an independent network of the communication network **(read as the Internet)(Fig. 1, line 9)**, the request message thereafter being transmitted to the device **(the sales server) (Col.9, line 4)** for providing the paying services within an independent network, the request message thereafter being transmitted to the device for providing the payment services **(Col. 4, lines 58-63)** , except that it does not specifically teach wherein the user identification device is one of an SIM and a USIM, and wherein a command set implemented in the user identification device, as specified in one of a SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit, generates the request message . However, Pailles teaches wherein the at least one message is formulated as a command set implemented in the user identification device as specified in one of an SIM Application Toolkit, a USIM Application Toolkit, and a Card Application Toolkit **(Pg.3, [0058], and [0071])**. Therefore it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Pailles into Capitant to use one of an SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit to guarantee the integrity and confidentiality of messages **(Pg. 3, [0071])**.

Consider **Claim 24**, Capitant et al. clearly teach and disclose a device for providing paying services within a radio communication network operating in accordance with one of a GSM Standard and a UMTS Standard, comprising: parts for evaluating at least one message generated by a user identification device of a radio communication terminal during a request for one of the paying services within an independent network of the communication network **(read as the**



**Internet)(Fig. 1, line 9 and Col. 6, lines 36-39)** made by the radio communication terminal **(read as management and/or payment center)(Col.4, line 61)**, wherein the user identification device is one of a SIM and a USIM **(Col. 6, lines 51-53)**, parts for initiating the requested paying service **(read as SIM)(Fig.2)**; and parts for providing the requested paying service **(read as Supplier's sales server and Payment server)(Fig. 5)**, except that it does not specifically teach and wherein a command set, implemented in the user identification device as specified in one of a SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit, generates the request message. However, Pailles teaches wherein a command set **(read as program execution function)(Pg. 3, [0058])**, implemented in the user identification device **(mobile phone)** as specified in one of an SIM Application Toolkit, a USIM Application Toolkit, and a Card Application Toolkit **(Pg.3, [0058], and [0071])**. Therefore it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Pailles into Capitant to use one of an SIM Application Toolkit, a USIM Application Toolkit and a Card Application Toolkit to guarantee the integrity and confidentiality of messages **(Pg. 3, [0071])**.

Consider **Claim 25**, Capitant et al. clearly teach and disclose a device for providing paying services as claimed in claim 24, wherein the device is embodied as a distributed arrangement including a network control device **(read as management center)(Fig.5)** of the radio communication system for controlling a server, with the network control device including both the parts for evaluating **(Fig.5, Block 50)** and the parts for initiating **(Fig.5, Block 52)** the requested paying services.

Consider **Claim 26**, Capitant et al. clearly teach and disclose a device for providing paying services as claimed in claim 24, wherein the device is embodied as a server (**read as Payment server**) (**Fig.5**).

4. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Capitant. (US 6976011) in view of Pailles (US 2004/0083166 A1) and further in view of Sivula (US 006907239 B1).

Consider **Claim 20**, Capitant teaches a method for providing paying services, except that it does not specifically teach wherein the paying services are at least one of a transfer of mobile emails, instant messaging, video telephony, a multimedia messaging service and a short message service, and the at least one message contains, depending upon a type of requested service, additional data required for providing the service. However, Sivula et al. teach wherein the paying services are at least one of a transfer of mobile emails, instant messaging, video telephony, a multimedia messaging service and a short message service, and the at least one message contains, depending upon a type of requested service, additional data (**list**) required for providing the service (**Col. 6, lines 58-67**).

Therefore it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Sivula into Capitant to use paying services wherein the paying services are at least one of a transfer of mobile emails, instant messaging, video telephony, a multimedia messaging service and a short message service to provide a list of services that the service provider offers,

and the at least one message (**read as conveying a list of services**)(Col.6, line 61) contains, depending upon a type of requested service, additional data required for providing the service.

*Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon R. Brooks whose telephone number is (571) 270-1115. The examiner can normally be reached on 7:30a.m. to 5p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shannon Brooks

January 11, 2007

  
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